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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

HENNING, MATTHEW T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,725

Applicant(s)

MURASE ET AL.

Examiner

Matthew T. Henning

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/13/04 8/30/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This action is in response to the communication filed on 2/6/2002.

DETAILED ACTION

Claims 1-44 have been examined.

Title

The title of the invention is acceptable.

Priority

This application claims priority to Japan Application 2001-039140, filed on 2/15/2001.

Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 2/15/2001.

Information Disclosure Statement

The information disclosure statement(s) (IDS) submitted on 5/13/2004, and 8/30/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Drawings

The drawings filed on 2/6/2002 are acceptable for examination proceedings.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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1
2 The abstract of the disclosure is objected to because:

3 Line 2 recites "is provided" which can be implied and must therefore be removed.

4 Correction is required. See MPEP § 608.01(b).

5 ***Claim Rejections - 35 USC § 112***

6 The following is a quotation of the second paragraph of 35 U.S.C. 112:

7 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
8 subject matter which the applicant regards as his invention.

9
10 Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for
11 failing to particularly point out and distinctly claim the subject matter which applicant regards as
12 the invention.

13 The term "enough" in claims 19 and 21 is a relative term which renders the claim
14 indefinite. The term "enough" is not defined by the claim, the specification does not provide a
15 standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be
16 reasonably apprised of the scope of the invention. One of ordinary skill in the art would be
17 unable to determine what amount of "processing capacity" would be "enough processing
18 capacity" and would therefore be unable to determine the scope of the claim. As such, claims
19 19-21 are rejected for failing to particularly point out and distinctly claim the subject matter
20 which the applicant regards as the invention.

21 ***Claim Rejections - 35 USC § 101***

22 35 U.S.C. 101 reads as follows:

23 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
24 any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
25 requirements of this title.
26

1 Claims 25-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed
2 to non-statutory subject matter. Claims 25-34 are directed to a program. Although the program
3 is intended to be executed on a computer, only the program is being claimed and as such is non-
4 statutory.

5 ***Claim Rejections - 35 USC § 102***

6 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
7 basis for the rejections under this section made in this Office action:

8 *A person shall be entitled to a patent unless –*

9
10 *(e) the invention was described in a patent granted on an application for patent by another filed in the*
11 *United States before the invention thereof by the applicant for patent, or on an international application by*
12 *another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the*
13 *invention thereof by the applicant for patent.*
14

15 The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999
16 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002
17 do not apply when the reference is a U.S. patent resulting directly or indirectly from an
18 international application filed before November 29, 2000. Therefore, the prior art date of the
19 reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA
20 35 U.S.C. 102(e)).

21 Claims 1-8, 12-18, 35-38, and 41-43 are rejected under 35 U.S.C. 102(e) as being
22 anticipated by Matsushita (US Patent Number 6,694,002) hereinafter referred to as Matsushita.

23 The applied reference has a common assignee with the instant application. Based upon
24 the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.
25 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37
26 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

1 inventor of this application and is thus not the invention “by another,” or by an appropriate
2 showing under 37 CFR 1.131.

3 Regarding claim 1, Matsushita disclosed a data nullification device for nullifying target
4 data recorded on a recording medium the target data being made up a plurality of data blocks
5 (See Matsushita Abstract and Figs. 1 and 4), the data nullification device comprising: a judging
6 unit (See Matsushita Figs. 1 Element 18) operable to judge, for each data block recorded on the
7 recording medium, whether the data block needs be nullified (See Matsushita Fig. 4 Step S3a
8 and Col. 6 Lines 31-57); and a nullifying unit (See Matsushita Fig. 1 Element 21) operable to
9 nullify, when a predetermined number of data blocks are judged as needing to be nullified or
10 when one or more data blocks whose total amount of data reaches a predetermined amount are
11 judged as needing to be nullified, the judged data blocks (See Matsushita Col. 6 Lines 41-54).

12 Regarding claim 35, Matsushita disclosed a data nullification method for nullifying target
13 data recorded on a recording medium, the target data being made up of a plurality of data blocks,
14 the data nullification method comprising the steps of: judging, for each data block recorded on
15 the recording medium, whether the data block needs to be nullified (See Matsushita Fig. 4 Step
16 S3a and Col. 6 Lines 31-57); and nullifying, when predetermined number of data blocks are
17 judged as needing to be nullified or when one or more data blocks whose total amount of data
18 reaches a predetermined amount are judged as needing to be nullified, the judged data blocks
19 (See Matsushita Col. 6 Lines 41-54).

20 Regarding claims 2, and 36, Matsushita disclosed that the recording medium stores
21 sequence information that shows a sequence in which the plurality of data blocks were recorded
22 onto the recording medium and the judging unit judges, in succession, the plurality of data

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1 blocks in the sequence shown by the sequence information, as needing to be nullified (See
2 Matsushita Figs. 1 and 4, and Col. 6 Lines 29-57).

3 Regarding claims 3, and 37, Matsushita disclosed that the target data is data which is
4 continuously transmitted from an external device and recorded on the recording medium (See
5 Matsushita Col. 5 Line 45 – Col. 6 Line 12), the data nullification device further comprises:
6 receiving unit operable to receive data from the external device (See Matsushita Fig. 1 Element
7 17), and having set the received data as a new data block, the nullifying unit writes the new data
8 block to recording area on the recording medium that stores a data block which is judged as
9 needing to be nullified, nullify the recorded data block and at the same time record the new data
10 block (See Matsushita Col. 5 Lines 48-51 and Col. 6 Lines 24-28).

11 Regarding claim 4, Matsushita disclosed that each data block has a length corresponding
12 fixed transmission time period, a specified number of recording areas which are each used as a
13 recording area of a data block are reserved on the recording medium (See Matsushita Col. 5 Line
14 66 – Col. 6 Line 6).

15 Regarding claim 5, Matsushita disclosed that if the length corresponding to the fixed
16 transmission time period is variable and if part of the recorded data block remains even after the
17 new data block is written, the nullifying unit further writes arbitrary data over the part of the
18 recorded data block (See Matsushita Col. 6 Lines 51-54).

19 Regarding claim 6, Matsushita disclosed that if there is not a new data block is which to
20 be recorded, the nullifying unit writes arbitrary data to the recording area (See Matsushita Col. 6
21 Lines 51-54).

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1 Regarding claims 7, 12, 38, and 41, Matsushita disclosed a utilizing unit operable to
2 utilize the target data recorded on the recording medium, wherein the judging unit data block
3 which was utilized by in units of data blocks, further judges that each the utilizing unit needs
4 nullified (See Matsushita Col. 6 Lines 29-57).

5 Regarding claim 8, and 13 Matsushita disclosed that the target data is content data which
6 is transmitted from an external device and recorded on the recording medium (See Matsushita
7 Col. 5 Lines 45-65 and Abstract), the content data is accompanied with copy control information
8 showing whether copying of the content data is permitted or prohibited (See Matsushita Col. 5
9 Lines 51-53), the utilizing unit reproduces the content data recorded on the recording medium, in
10 units of data blocks, and only if the copy control information accompanying the content data
11 shows that the copying of the content data is prohibited, the judging unit judges that each data
12 block which was reproduced by the utilizing unit needs to be nullified (See Matsushita Col. 6
13 Lines 31-54).

14 Regarding claim 14, Matsushita disclosed that the target data is accompanied with copy
15 control information showing whether copying of the target data permitted or prohibited (See
16 Matsushita Col. 5 Lines 51-53), the utilizing unit records the on the recording medium, to
17 another target data recorded recording medium, units of data blocks, and only if the copy control
18 information accompanying the target data shows that the copying of the target data is prohibited,
19 the judging unit judges that each data block on the recording medium which was recorded by the
20 utilizing unit needs to be nullified (See Matsushita Col. 6 Lines 31-54 and Col. 6 Line 66 – Col.
21 7 Line 11).

4 Regarding claims 16, and 43, Matsushita disclosed that the nullifying unit destroys at
5 least a part of a data block which is judged as needing to be nullified, the part of the data block
6 being necessary to utilize remaining parts of the data block (See Matsushita Col. 6 Lines 51-54).

7 Regarding claim 17, Matsushita disclosed that the target data is MPEG data including I
8 pictures, and the part of the data block necessary to utilize the remaining parts the data block an I
9 picture (See Matsushita Col. 6 Lines 51-54 and Col. 6 Line 67 – Col. 7 Line 2).

10 Regarding claim 18, Matsushita disclosed that the target data is MPEG data including I
11 pictures, and the part of the data block necessary to utilize the remaining parts of the data block a
12 first sector of an I picture (See Matsushita Col. 6 Lines 51-54 and Col. 6 Line 67 – Col. 7 Line
13 2).

14 *Claim Rejections - 35 USC § 103*

15 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
16 obviousness rejections set forth in this Office action:

17 *A patent may not be obtained though the invention is not identically disclosed or*
18 *described as set forth in section 102 of this title, if the differences between the subject matter*
19 *sought to be patented and the prior art are such that the subject matter as a whole would have*
20 *been obvious at the time the invention was made to a person having ordinary skill in the art to*
21 *which said subject matter pertains. Patentability shall not be negated by the manner in which*
22 *the invention was made.*

24

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1 Claims 25-28, and 31-33 are rejected under 35 U.S.C. 103(a) as being obvious over
2 Matsushita.

3 The applied reference has a common assignee with the instant application. Based upon
4 the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C.
5 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37
6 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the
7 inventor of this application and is thus not an invention "by another"; (2) a showing of a date of
8 invention for the claimed subject matter of the application which corresponds to subject matter
9 disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference
10 under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the
11 application and reference are currently owned by the same party and that the inventor named in
12 the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in
13 accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the
14 reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C.
15 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

16 Regarding claim 25, Matsushita disclosed a data nullification method for nullifying target
17 data recorded on a recording medium, the target data being made up of a plurality of data blocks,
18 the data nullification method comprising: judging, for each data block recorded on the recording
19 medium, whether nullified; and the data block needs to nullifying (See Matsushita Fig. 4 Step
20 S3a and Col. 6 Lines 31-57), when a predetermined number of data blocks are judged as needing
21 to be nullified or when one or more data blocks whose total amount of data reaches a
22 predetermined amount are judged as needing to be nullified, the judged data blocks (See

1 Matsushita Col. 6 Lines 41-54), but failed to disclose method being implemented in software.
2 However, it was well know that the functionality of a system can be implemented in software in
3 order to provide for greater ease of upgrade. Therefore, it would have been obvious to the
4 ordinary person skilled in the art at the time of invention to implement the system of Matsushita
5 in software running on a processor. This would have been obvious because the ordinary person
6 skilled in the art at the time of invention would have been motivated to ensure the system could
7 be easily upgraded.

8 Regarding claim 26, see the rejection of claim 2 above.

9 Regarding claim 27, see the rejection of claim 3 above.

10 Regarding claims 28 and 31, see the rejection of claim 7 above.

11 Regarding claim 32, see the rejection of claim 15 above.

12 Regarding claim 33, see the rejection of claim 16 above.

13 Claims 9-11, 29-30, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable
14 over Matsushita as applied to claims 1, 25, and 35 above, and further in view of Garfinkle (US
15 Patent Number 5,400,402).

16 Regarding claims 9, 29, and 39, Matsushita disclosed judging whether data blocks needed
17 to be nullified or not and whenever any data block is judged as needing to be nullified, the
18 nullifying unit nullifies the data block irrespective of whether the predetermined number of data
19 blocks are judged as needing to be nullified or whether one or more data blocks whose total
20 amount of data reaches the predetermined amount are judged as needing to be nullified (See
21 Matsushita Col. 51-54), but failed to disclose the data blocks having an expiration time at which
22 they would need to be nullified.

1 Garfinkle teaches that downloaded content should be given a time limit and once the time
2 limit is reached the content should be erased (See Garfinkle Col. 2 Lines 26-35).

3 It would have been obvious to the ordinary person skilled in the art at the time of
4 invention to employ the teachings of Garfinkle in the content system of Matsushita by providing
5 a time limit with the content packets and erasing the content packets once the time limit was
6 over. This would have been obvious because the ordinary person skilled in the art at the time of
7 invention would have been motivated to control the use of the received content.

8 Regarding claims 10, 30, and 40, see the rejection of claim 7 above.

9 Regarding claim 11, see the rejection of claim 8 above.

10 Claims 19-24, 34, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over
11 Matsushita as applied to claims 1, 16, 25, and 35 above, and further in view of Masinter (US
12 Patent Number 5,742,807).

13 Regarding claims 22, 34, and 44, Matsushita disclosed that each data block recorded on
14 the recording medium has been encrypted using an individual encryption key (See Matsushita
15 Col. 5 Lines 57-62), and a decryption key for decrypting the encrypted data block is stored on
16 the recording medium (See Matsushita Col. 5 Lines 57-62 and Col. 6 Lines 41-45), but failed to
17 disclose destroying the key when the data block is judged to be erased.

18 Masinter teaches that data which is encrypted can be destroyed simply by destroying the
19 decryption key for the data (See Masinter Col. 2 Lines 57-61) and that the key used to encrypt
20 and decrypt the data can be a hash of the data (See Masinter Col. 2 Lines 54-56)

21 It would have been obvious to employ the teachings of Masinter in the content erasing
22 system of Matsushita by only destroying the decryption key for each packet judged to be erased.

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1 This would have been obvious because the ordinary person skilled in the art would have been
2 motivated to decrease the amount of overwriting required to erase each packet.

3 Regarding claim 23, the combination of Matsushita and Masinter disclosed an acquiring
4 unit operable to acquire the target data in an encoded form (See Matsushita Col. 6 Lines 41-45);
5 a decoding unit operable to decode the encoded target data using a user key which has been
6 provided to authorized users in advance, to obtain the target data (See Matsushita Col. 6 Lines
7 41-45); a key generating unit operable to generate an arbitrary encryption key and a decryption
8 key corresponding to the encryption key, for each data block of the target data (See Masinter
9 Col. 5 Lines 40-48); a data encrypting unit operable to encrypt the data block using the
10 encryption key so that the encrypted data block can be decrypted using the corresponding
11 decryption key (See Masinter Col. 2 Lines 54-56); a key encrypting unit operable to encrypt the
12 decryption key using an identifier unique to the data nullification device (See Masinter Col. 4
13 Paragraph 2); and recording unit operable to record the encrypted data block and the encrypted
14 decryption key onto recording medium (See Matsushita Col. 5 Lines 45-65).

15 Regarding claim 24, the combination of Matsushita and Masinter disclosed that at least
16 the decoding unit, the key generating unit, the data encrypting unit, and the key encrypting unit
17 are contained in a single semiconductor chip (See Matsushita Fig. 1).

18 Regarding claims 19-21, the combination of Matsushita and Masinter disclosed that when
19 the data nullification device does not have an enough processing capacity, the nullifying unit
20 destroys only the part of the data block necessary to utilize the remaining parts of the data block
21 (See the rejection of claim 22 above), a destroying unit operable to destroy remaining parts of

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1 data blocks which were not destroyed by the nullifying unit, when the data nullification device
2 has an enough processing capacity (See Matsushita Col. 5 Line 45 – Col. 6 Line 11).

3 *Conclusion*

4 Claims 1-44 have been rejected.

5 The prior art made of record and not relied upon is considered pertinent to applicant's
6 disclosure.

7 a. Langford (US Patent 6,507,911) disclosed a system wherein data is overwritten
8 upon deletion in order ensure no future access to the data.

9 b. Park (US Patent 5,796,826) disclosed a system wherein in order to delete data
10 blocks, the key used to encrypt the blocks was deleted.

11 c. Maeda et al. (US Patent Number 5,764,607) disclosed a system wherein upon
12 copying a copy protected file, the original was erased.

13 d. Yoshida (US Patent Number 4,975,898) disclosed a system which overwrites
14 copies of optical discs.

15 e. Mardirossioan (US Patent Number 5,896,255) disclosed a system which erases
16 original data once a copying limit has been reached.

17 f. Ross (US Patent Number 4,462,078) disclosed a system that deletes original data
18 upon copying.


19 Any inquiry concerning this communication or earlier communications from the
20 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.


21 The examiner can normally be reached on M-F 8-4.

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1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
9 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10
11 
12 Primary Examiner
13 AU2131
9/23/05

14 
15 Matthew Henning
16 Assistant Examiner
17 Art Unit 2131
18 9/22/2005
19